REMARKS

Introduction

Claims 15-17 and 23-28 are pending. In the final office action mailed on December 18, 2002 (Paper No. 15), the Examiner rejected claims 15, 16, 26, and 27 under 35 U.S.C. § 103(a) over User's Guide for Microsoft Project ("Project User's Guide") and Using Microsoft Project 4 ("Using Project"); rejected claims 23 and 24 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, and Eisner, The Essentials of Project and Systems Engineering Management ("Eisner"); rejected claims 17 and 28 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, and Kroenke, Database Processing: Fundamentals, Design, and Implementation ("Kroenke"); and rejected claim 25 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, Eisner, and Kroenke.

Applicant's Techniques

Applicants have created a system for managing and monitoring the development of a product, such as a software product release. In some embodiments, applicants' techniques solicit from users desired features for the product, such as users who are marketing personnel or prospective purchasers of the product. For each of a number of features chosen for inclusion in the product, applicants' techniques solicit and store one or more tasks that must be completed by developers in order to incorporate the feature into the product--these tasks are said to be linked to the product feature. In some embodiments, applicants' techniques further group the solicited tasks into task groups.

Prior Art Rejections

As described above, applicants' techniques provide for tracking the progress of a product development process by linking tasks to the product's features. In that regard, claim 15 recites "defining a plurality of tasks, wherein each of said tasks is

associated with one of said product features, the plurality of tasks being grouped into task types; linking each of the plurality of tasks with one of the plurality of product features"; claim 23 recites "an engineer task list user interface by which the user enters and tracks information related to tasks being completed to implement the product features entered in the feature list interface, wherein the tasks correspond to one of the product features"; and claim 26 recites "defining, for each feature, a plurality of tasks necessary to implement the feature; linking each task with its corresponding feature". Each of the other pending claims is dependent from one of these three independent claims.

In the non-final office action mailed on October 9, 2002, the Examiner rejected all of the pending claims over combinations all containing of two references describing a Microsoft Project software package: Project User's Guide and Using Project. In applicants' view, these two references make clear the following: (1) Microsoft Project can be used to track a project by tracking progress on a number of tasks. Such tasks may be grouped together under a summary task that corresponds to a larger process made up of the tasks grouped under it. For example, the following tasks may be grouped under a "Finance Phase" summary task: "Create Business Plan," "Present to Current Investors," "Meet With Bankers," etc. (2) Microsoft Project imposes no control over the text entered for summary tasks, and is therefore unable to prevent a user from entering text for summary tasks that, rather than referring to a larger process made up of the tasks grouped under them, instead refers to product features to which the tasks grouped under them relate.

In the October 9 office action, while explicitly acknowledging that the cited two Project references fail to disclose linking tasks to product features as recited, the Examiner indicated that it would have been obvious to one of ordinary skill in the art at the time the application was filed to exploit the flexibility of Microsoft Project described in (2) above to enter text for summary tasks that refers to product features to which the

tasks grouped under the summary tasks relate. The Examiner included examples of such summary tasks whose text refers to product features to which the tasks grouped under the summary tasks relate. Applicants assume that those examples were prepared by the Examiner as part of preparing this office action, as no other source was cited. The Examiner failed to identify any motivation for this modification, however.

In the present office action, the Examiner cited and discussed three new references not cited by applicants in an IDS: U.S. Patent No. 6,347,258 to Hsu et al. ("Hsu"); U.S. Patent No. 5,036,472 to Buckley et al. ("Buckley"), and Florida Technology Development Corporation – Integrated Product and Process Design Print Quality Analyzer, Microview Systems ("Florida Technology"). In order to justify the finality of the present office action, the Examiner clearly indicated that he was maintaining the rejections of the October 9 office action without altering their basis, and using the newly-cited references only to support his assertion in the October 9 office action that Microsoft Project is flexible enough to permit a user to enter product features in place of summary tasks.

As indicated above, applicants readily concede that Microsoft Project is flexible enough to permit a user to enter product features in place of summary tasks. Accordingly, applicants concur that it was <u>possible</u> to modify the two references describing Microsoft Project as proposed by the Examiner.

However, to make a prima facie case of unpatentability under 35 U.S.C. § 103(a), it is insufficient to merely demonstrate that it is possible to modify the cited references in accordance with the rejected claims. Rather, the Examiner must identify a source of motivation that would have caused one of ordinary skill in the art to perform the necessary modification. MPEP § 706.02(j).

As mentioned above, the Examiner did not identify any such source of motivation in the October 9 office action. The Examiner also failed to identify any such source of

motivation in the prior art rejections of the present office action. Because the Examiner designated the present office action as final, the Examiner is unable to use the three newly-cited references to provide new evidence of such motivation. MPEP § 2144.03(D) makes it very clear that, in the absence of amendments to all of the rejected claims, new references may be added in final office actions only to support earlier assertions by the Examiner of what was common knowledge, and not to rely on any additional teachings of the new references. If the Examiner wishes to rely on one or more of the three new references to show a motivation to modify as required for a proper rejection under 35 U.S.C. § 103(a), applications respectfully request that the Examiner remove the finality of the present office action.

Even if the Examiner did make the present action non-final in order to rely on the three new references to show a motivation to modify, however, these references would not succeed in showing such a motivation, as there is no indication among these references that any sort of connection was made between product features and tasks before the making of applicants' invention. As for the Florida Technology reference discussed by the Examiner, while the portion of this reference provided by the Examiner shows both (1) a "House of Quality" grid listing features generated while designing a product and (2) a Gantt chart produced with Microsoft Project showing the product's development schedule, including ranges of times for performing each of a number of tasks making up the development project, nothing in the provided portion makes any attempt to link, combine, or otherwise relate these two separate bodies of information.

Although ambiguous, the Examiner appears to assert that, in Florida Technology, both the House of Quality grid and the Gantt chart were produced using Microsoft Project. (pp. 5-6: "For purposes of project planning, the team used Microsoft Project, as shown in the enclosure. Specifically, MicroView used project not only to build the 'House of Quality' metric standardization table, but also to develop a concept-

screening matrix. Furthermore, MicroView used Microsoft project to determine a planned timeline for developing and building the system, as shown in the enclosure.") Applicants can find nothing in the provided portion of Florida Technology to support this assertion, and the different styles of these two documents suggest to applicants that they were generated using different software packages. If the Examiner wishes to rely on a position that both the House of Quality grid and the Gantt chart were produced using Microsoft Project, applicants respectfully request that the Examiner: (1) substantiate the position, either by (a) providing a portion of Florida Technology that states that both documents were prepared using Microsoft Project, or (b) in light of the Examiner's apparent participation in the project described in Florida Technology, an affidavit stating clearly that both documents were prepared using Microsoft Project and describing the process by which they were prepared; (2) identifying the section of 35 U.S.C. § 102 under which Florida Technology constitutes prior art to present application; and (3) providing suitable evidence that Florida Technology constitutes prior art to the present application under that section. Alternatively, applicants suggest that the Examiner identify portions of Project User's Guide or Using Project that indicate that Microsoft Project can be used to generate such a House of Quality grid identifying product features.

Even if the Examiner was successful in establishing that both documents were produced using Microsoft Project, however, this would not complete a prima facie case of unpatentability under 35 U.S.C. § 103(a), as there remains no indication that product features contained in the House of Quality grid are in any way linked to or otherwise related to the tasks shown in the Gantt chart.

Because the Examiner has failed to cite a reference describing the linking of product features to development tasks as recited by the pending claims, and because the Examiner has failed to advance any evidence—let alone adequate evidence— showing that one of ordinary skill in the art would, at the time of filing, would have been

motivated to modify the cited references in this manner, the present rejections of the pending claims fail to establish a *prima facie* case of unpatentability under 35 U.S.C. § 103(a).

Additionally, even if the Examiner succeeded at making a prima facie case of unpatentability under 35 U.S.C. § 103(a), applicants believe that this prima facie case would ultimately be rebutted, for at least the following reasons: (1) The references describing Microsoft Project, by describing entering task groups where the Examiner proposes entering features, teach away from the modification proposed by the Examiner. (2) The modification proposed by the Examiner destroys important utility of Microsoft Project, as it prevents the attribution of tasks to summary tasks as described by the cited references. As one example, in the Examiner's proposed listing of tasks under product features, because the "Send replaced processor to parts supply" task is listed under the "1600 MHz Pentium processor" feature and the "Send replaced stick to parts supply" task is listed under the "Ram – 256 Mbytes" feature, these two tasks cannot be listed under a "Return unneeded parts to parts supply" summary task as intended by the references describing Microsoft Project. (3) Assuming a user does replace summary tasks with features in accordance with the modification proposed by the Examiner, the project no longer contains task types, as required at least by claim 15.

Additionally, claim 15 recites "tracking the status of each feature." The fact that the Examiner has similarly failed to identify a prior art reference showing this act or a source of motivation to add it lends further support to the impropriety of the present rejection of claims 15-17.

Additionally, claim 23 recites "a product feature list user interface by which a user enters desired feature of the product to be released." While the rejection of claim
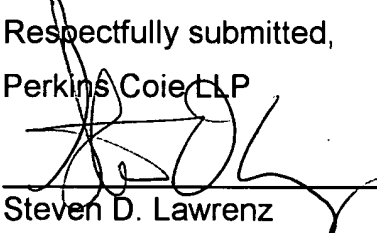
23 asserts that this feature is discussed in the rejection of claim 15, it is not, lending further support to the impropriety of the present rejection of claims 23-28.

Conclusion

In view of the foregoing, applicants respectfully request that the Examiner reconsider and withdraw each of the pending rejections.

Respectfully submitted,

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